

Arguments

Applicants respectfully urge that the reasoning offered by the Examiner to object to the claims in the instant application is incorrect. Applicants urge that when viewed in the context of the controlling law, the reissue oath/declaration is not defective, the error is one which can be relied upon to support reissue and the specification manifests an intention to claim the subject matter of the newly added claims. The application is fully consistent with the requirements of 35 U.S.C. §251. The objection to claims 16-63 should be withdrawn and the application should be examined on the merits.

I. The reissue oath/declaration filed with the application is not defective. The error that is relied upon to support the reissue application is an error upon which reissue can be based.

As pointed out in Applicants' earlier request for reconsideration, the Examiner's original conclusion that the failure to timely file a divisional application is not an error upon which a reissue can be based is not applicable in the instant analysis. The Examiner has acknowledged that no restriction requirement was made in any of the applications related to the instant application.

In cases where no restriction requirement has been made, the law does not prevent *per se* Applicants from adding claims in a reissue application that could have been subject to an earlier filed voluntary divisional application. The Federal Circuit made it clear in *In re Swartzel*, 36 U.S.P.Q.2d 1510 (Fed. Cir. 1995), that the "divisional doctrine" of *In re Orita*, 550 F.2d 1277

(C.C.P.A. 1977), which bars the addition of claims in a reissue application that were not elected in response to a restriction requirement, does not apply where no restriction requirement has been made even if the PTO's actions during earlier prosecution are "tantamount" to restriction requirement." 36 U.S.P.Q.2d at 1512.

Unlike *Orta* and *Swartzel*, no restriction requirement and no PTO action tantamount to a restriction requirement occurred during in the prosecution of the instant application. The Examiner's original conclusion that Applicants' failure to timely file a divisional application is not an error upon which reissue can be based was therefore incorrect.

II. The added claims are directed to an invention disclosed in the original patent

As required by *In re Rowand* 187 U.S.P.Q.487 (C.C.P.A. 1975), the added claims are directed to an invention disclosed in the original patent. In citing *Rowand*, the Examiner incorrectly concluded that the newly added claims are not directed to an invention disclosed in the original patent because "the newly added claims are directed to processes of making a composition while the original claims were drawn to a composition. In addition, the new claims are not drawn to a process of making the same composition that was patented but rather one of much different scope." See Office Action dated February 22, 2000, page 2.

The court in *Rowand* affirmed the Board's rejection under 35 U.S.C. § 251 of newly added method claims in an application for reissue of a patent that contained only apparatus claims. The reason for the affirmance, however, was not that the added claims were method

claims and the original claims were apparatus claims. Rather, the court stated that the rejection was affirmed because "there is nothing in the original patent evidencing that appellants intended to claim a method of making tubing or that appellants considered the method now claimed to be their invention." 187 U.S.P.Q. at 488. The court stated that

Determining what protection appellants intended to secure by their original patent for the purposes of § 251 is an essentially factual inquiry confined to the objective intent manifested by the original patent.

and detailed the complete lack of language in the patent specification that indicated that the applicants considered the methods to be the invention. *Id.* at 489.

In the instant application, the specification is replete with clear and unambiguous statements that Applicants consider the methods to be their invention. As noted above, Applicants state that the "Field of the Invention" includes skin care compositions and "methods for making such compositions" (Column 1, lines 15-19). Furthermore, in presenting the examples of the invention, the Applicants note that

The advantages of the invention and specific embodiments of the skin care compositions **prepared in accordance with the present invention** are illustrated by the following examples.

(Column 7, lines 41-44). As distinguished from *Rowand*, the original patent in the instant application clearly manifests an objective intent by Applicants to include the methods of making the compositions as part of the subject matter sought to be protected as their invention.

The Examiner's statement that "the new claims are not drawn to a process of making the same composition that was patented but rather one of much different scope" is not relevant to the analysis of whether the newly added claims are encompassed by the invention disclosed in the original patent. Section 251 expressly allows applicants to add claims when the original patent is

deemed wholly or partly inoperative or invalid,, by reason of the patentee claiming more or less than he had a right to claim in the patent.

35 U.S.C. §251(1). The claims added in the reissue application are thus directed to an invention that was disclosed in the original patent.

III. *In re Mead* does not state that claims must be directed to a different embodiment of the originally claimed invention

The Examiner misstated the test in *Mead*. In responding to Applicants' arguments distinguishing the instant application from the "divisional doctrine", the Examiner urged that the correct test is found in *Mead* and asserted that *Mead* requires that the newly added claims must be directed to a different embodiment of the originally claimed invention. *See* Office Action dated October 24, 2000, page 2. This is a complete misreading and misapplication of *Mead*. In *Mead*, the Board asserted that the newly added claims were directed to an independent and distinct invention. *See* 198 U.S.P.Q. 412 (C.C.P.A. 1978). Applicants asserted that the newly added claims were directed to different embodiments of the same invention and, even if they were directed to an independent and distinct invention, Applicants still had the right to allowance of the claims through a reissue application. The court held that the newly added claims were

directed to different embodiments of the same invention; consequently, the issue of whether applicant had the right to claim an independent and distinct invention was not considered.

The court in *Mead*, however, did cite to and follow *Rowand*, stating that the intent to claim requirement refers to an objective intent “analogous to the requirement of §112, first paragraph” *Id.* at 417. *Mead* was ultimately decided on an express admission made by the applicants’ attorney that the applicants did not intend to claim the subject matter of the newly added claims in the original patent. *Mead* was not decided on the issue of independent and distinct inventions and cannot properly be interpreted to require that reissue claims must be directed to a different embodiment of the originally claimed invention in order to be a correctable error.

IV. The specification manifests intent to claim the subject matter of the newly added claims

As noted above, consistent with *Rowand*, the specification in the instant application contains express statements manifesting Applicants’ intent to claim the instant process. The newly added claims are directed to the invention in the original patent. When the proper legal standards are applied, the evidence of record fully supports the conclusion that the specification conveys Applicants’ possession of the claimed invention and intention to claim it.

The “intent to claim” test, as set forth in *Rowand* and *Mead*, refers to evidence found in the specification that indicates that applicants considered the subject matter of the newly added

claims to be part of the invention. The instant application unambiguously contains manifestations of such intent.

The law requires that the newly added claims must be directed to the invention of the original patent. It does not require that the newly added claims must be directed to the subject matter of the original claims. In *Swartzel* the Federal Circuit expressly ruled out extending the “divisional doctrine” of *Orta* and *Watkinson* to cases where no restriction requirement had been made, even if the PTO’s action was tantamount to a restriction requirement. In the instant application there was no restriction requirement and no PTO action tantamount to a restriction requirement and Applicants’ intent to claim the subject matter of the newly added claims in the original patent is clear. Accordingly, the subject matter of the newly added claims is directed to the invention in the original patent.

V. The newly added claims are for same general invention as required by MPEP 1412.01

MPEP 1412.01 states that the invention claimed in a reissue application does not have to have been claimed in the original patent. Rather, “the entire disclosure, not just the claim, is considered in determining what the patentee objectively intended as his invention” and “some disclosure in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.” *In re Amos*, 953 F.2d 613, 618,

21 USPQ2d 1271, 1274 (Fed. Cir. 1991), which provides a detailed discussion of the analysis to be used in determining the intent to claim, is cited.

Amos is instructive as to the meaning of the phrases "intent to claim," "the invention disclosed in the original patent" and "the same invention" in the context of § 251. *Amos* makes clear that the intent to claim requirement relates to the content of the specification and its conveyance of applicant's possession and teaching of the invention. The notion of different embodiments of the same invention versus independent and distinct inventions, as is applied in restriction requirements, is conspicuously absent from the detailed analysis provided in *Amos*.

When viewed in light of the standard set forth in MPEP 1412.01, and the analysis in *Amos*, the facts in the instant application clearly support a finding that the subject matter in newly added claims is disclosed in the original patent and that Applicants intended to claim the subject matter of the newly added claims.

VI. The newly added claims are directed to the invention disclosed in the original patent as required by MPEP 1450

MPEP 1450 states

If the reissue application contains claims to an independent and distinct invention which was not claimed in the original patent, these claims may be treated by a suitable rejection, such as not being "for the invention disclosed in the original patent," as evidenced by the claims in the original patent*>(<*In re Rowand*, >526 F.2d 558, < 187 USPQ 487 (CCPA 1975)>)< lack of inoperativeness of, or defect in, the original patent; lack of error; or not being for matter which might have been claimed in the original patent.

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The Examiner has objected to the claims' accordingly. In responding to the objection, Applicants have specifically pointed to the objective intent manifest in the original patent and therefore have established that the newly added claims are directed to the invention disclosed in the original patent. MPEP 1450's reference to "reissue applicant's failure to timely file a divisional application" is a reference to the divisional doctrine discussed above and does not apply to the instant application. In the instant application, there was no restriction requirement made during prosecution of the original application, so there was no failure to timely file a divisional application. Moreover, the express language included in the specification indicates that Applicants consider the subject matter of the newly added claims to be their invention and manifests the objective intent to claim the invention in the original patent.

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Conclusion

For the foregoing reasons, Applicants respectfully submit that the reissue application is complete in all respects and in allowable form. Applicants respectfully assert that the error relied upon in support of the reissue application is an error upon which reissue can be based. Applicants respectfully assert that the subject matter of claims 16-63 covers the invention disclosed in the original patent. Applicants respectfully request reconsideration and withdrawal of the objection to claims 16-63 and examination and allowance of claims 1-63.

Respectfully submitted,



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Attachment: Table of Cases including copies of cases cited therein

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Table of Cases

In re Watkinson, 900 F.2d 230, 14 U.S.P.Q.2d 1407 (Fed. Cir. 1990)

In re Mead, 581 F.2d 251, 198 U.S.P.Q. 412 (C.C.P.A. 1978)

In re Swartzel, 36 USPQ 2d 1510 (Fed. Cir. 1995)

In re Orita, 550 F.2d 1277, 193 U.S.P.Q. 145 (C.C.P.A. 1977)

In re Rowand 526 F.2d 558, 187 USPQ 487 (CCPA 1975)

In re Amos, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991)